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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/824,193

04/14/2004

Elizabeth Colbert

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EXAMINER

PLUMMER, ELIZABETH A

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/824,193

Applicant(s)

COLBERT ET AL.

Examiner

Elizabeth A. Plummer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/06/2004, 08/15/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant's election with traverse of Species III in the reply filed on 10/11/2006 is acknowledged. The argument has found persuasive and the restriction has been withdrawn. This is a first Office action on the merits for application serial number 10/824,193 filed 04/14/2004. Claims 1-68 are pending.

### ***Drawings***

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

### ***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in

scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-36 and 56-68 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-36 and 56-68 of copending Application No. 10/823,419. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 37-55 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 37-55 of copending Application No. 10/823,419. Although the conflicting claims are not identical, they are not patentably distinct from each other. Regarding claims 37 and 47, copending Application No. 10/823,419 claims the invention except for the same percentage of binder. However, it would have been a matter of obvious design choice to one of ordinary skill in the art at the same time the invention was made to form the jointing material with a composition comprising 0.5% to 20% binder, as the applicant has not disclosed the critically of the weight percentages.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Objections***

5. Claims 1-9, 19-27, 37-46 and 56-62 are objected to because of the following informalities: claims 1-3, 19-21, 37-38 and 56-57 contain the phrase "substantially plane outer surface." However, the phrase is grammatically incorrect as the word "plane" can only be used as a noun or a verb. For purposes of examination, it is assumed that the word "plane" is intended to be an adjective with the definition of flat or

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level. The examiner suggests amending the claims to read "substantially planar outer surface." Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zuber et al. (PCT Publication WO 02/012144 A3) in view of Attard et al (US Patent 5,336,318).

a. Regarding claims 1 and 19, Zuber et al. discloses an interior construction system comprising one or more prefabricated drywall elements (page 1, lines 14-17; page 15, lines 7-10), at least one skim coat (page 15, lines 10-13) and at least one jointing material for assembling the one or more prefabricated drywall elements by jointing the drywall elements to form a substantially planar outer surface, wherein the jointing material, when dry substantially matches the skim coat (page 15, lines 10-19). The skim coat comprises a matching composition to the jointing material except with about 10 to 60% additional water (page 17, line 22). The jointing material comprises water (page 11, line 4), a binder (page 10, line 16), a mineral filler (page 10, line 15) and a thickener (page 9, 18-20). While Zuber et al. does not disclose that the thickener used in the jointing material and the corresponding skim coat comprises a noncellulosic thickener, it is notoriously

well known in the art of jointing material that a noncellulosic thickener can be used in combination with the typical cellulosic thickeners. For example, Attard et al. teaches a jointing compound comprising both a noncellulosic thickener of acidic acrylate copolymers and a cellulosic thickener (abstract) in order to improve crack resistance (column 2, lines 54-56) and reduce mixing times (column 2, lines 1-3). It would have been obvious to one ordinary skill in the art to modify Zuber et al. to include a noncellulosic thickener, such as taught by Attard et al., in order to create a stronger and quicker to use jointing compound.

b. Regarding claims 10 and 28, Zuber et al. discloses a method for the construction of an interior construction system comprising the steps of assembling prefabricated skim coated drywall elements by jointing material (page 1, lines 14-17; page 15, lines 7-10), wherein the skim coat (page 15, lines 10-13) and the jointing material substantially match when dry (page 15, lines 10-19), and drying the jointing material (page 20, line 4). The skim coat comprises a matching composition to the jointing material except with about 10 to 60% additional water (page 17, line 22). The jointing material comprises water (page 11, line 4), a binder (page 10, line 16), a mineral filler (page 10, line 15) and a thickener (page 9, 18-20). While Zuber et al. does not disclose that the thickener used in the jointing material and the corresponding skim coat comprises a noncellulosic thickener, it is notoriously well known in the art of jointing material that a noncellulosic thickener can be used in combination with the normal cellulosic thickeners. For example, Attard et al. teaches a jointing compound

comprising both a noncellulosic thickener of acidic acrylate copolymers and a cellulosic thickener (abstract) in order to improve crack resistance (column 2, lines 54-56) and reduce mixing times (column 2, lines 1-3). It would have been obvious to one ordinary skill in the art to modify Zuber et al. to include a noncellulosic thickener, such as taught by Attard et al., in order to create a stronger and quicker to use jointing compound.

c. Regarding claim 37, Zuber et al. discloses an interior construction system comprising one or more prefabricated drywall elements (page 1, lines 14-17; page 15, lines 7-10), at least one skim coat (page 15, lines 10-13) and at least one jointing material for assembling the one or more prefabricated drywall elements by jointing the drywall elements to form a substantially planar outer surface, wherein the jointing material, when dry substantially matches the skim coat (page 15, lines 10-19). The skim coat comprises a matching composition to the jointing material except with about 10 to 60% additional water (page 17, line 22). The jointing material comprises water (page 11, line 4), a binder (page 10, line 16), a mineral filler (page 10, line 15), an anti-cracking agent (page 9, lines 1-4), clay (page 9, lines 21-22), a thickener (page 9, 18-20), and talc (page 18, lines 18-19). While Zuber et al. does not disclose that the thickener used in the jointing material and the corresponding skim coat comprises a noncellulosic thickener or starch, it is notoriously well known in the art of jointing material that noncellulosic thickener and starch can be used in combination with the normal cellulosic thickeners. For example, Attard et al. teaches a jointing compound



comprising a noncellulosic thickener of acidic acrylate copolymers, starch, and a cellulosic thickener of hydroxypropyl methylecellulose (column 3, lines 20-34) in order to improve crack resistance (column 2, lines 54-56) and reduce mixing times (column 2, lines 1-3). It would have been obvious to one of ordinary skill in the art to modify Zuber et al. to include a noncellulosic thickener and starch, such as taught by Attard et al., in order to create a stronger and quicker to use jointing compound. Furthermore, because the applicant fails to show critically for the different percentages of each member of the composition claimed, the weight percentages listed are considered a matter of obvious design choice.

d. Regarding claim 47, Zuber et al. discloses a method for the construction of an interior construction system comprising the steps of assembling prefabricated skim coated drywall elements by jointing material (page 1, lines 14-17; page 15, lines 7-10), wherein the skim coat (page 15, lines 10-13) and the jointing material form a substantially planar outer surface and substantially match when dry (page 15, lines 10-19), and drying the jointing material (page 20, line 4). The skim coat comprises a matching composition to the jointing material except with about 10 to 60% additional water (page 17, line 22). The jointing material comprises water (page 11, line 4), a binder (page 10, line 16), a mineral filler (page 10, line 15), an anti-cracking agent (page 9, lines 1-4), clay (page 9, lines 21-22), a thickener (page 9, lines 18-20), and talc (page 18, lines 18-19). While Zuber et al. does not disclose that the thickener used in the jointing material and the corresponding skim coat comprises a noncellulosic thickener or starch, it is notoriously well

known in the art of jointing material that noncellulosic thickener and starch can be used in combination with the normal cellulosic thickeners. For example, Attard et al. teaches a jointing compound comprising a noncellulosic thickener of acidic acrylate copolymers, starch, and a cellulosic thickener of hydroxypropyl methylecellulose (column 3, lines 20-34) in order to improve crack resistance (column 2, lines 54-56) and reduce mixing times (column 2, lines 1-3). It would have been obvious to one of ordinary skill in the art to modify Zuber et al. to include a noncellulosic thickener and starch, such as taught by Attard et al., in order to create a stronger and quicker to use jointing compound. Furthermore, because the applicant fails to show critically for the different percentages of each member of the composition claimed, the weight percentages listed are considered a matter of obvious design choice.

e. Regarding claim 56, Zuber et al. discloses an interior construction system comprising one or more prefabricated drywall elements (page 1, lines 14-17; page 15, lines 7-10), at least one skim coat (page 15, lines 10-13) and at least one jointing material for assembling the one or more prefabricated drywall elements by jointing the drywall elements to form a substantially planar outer surface, wherein the jointing material, when dry substantially matches the skim coat (page 15, lines 10-19). The skim coat comprises a matching composition to the jointing material except with about 10 to 60% additional water (page 17, line 22). The jointing material comprises water (page 11, line 4), an organic binder (page 9, line 12-14), a mineral filler (page 10, line 15), a silicate-based agent

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(page 9, lines 1-3; page 10, line 21), a hydrophobic agent which is a silicone derivative (page 9, lines 1-3; page 10, line 18), and polyvinyl alcohol (page 9, lines 12-14) and a thickener (page 9, 18-20), and talc (page 18, lines 18-19). While Zuber et al. does not disclose that the thickener used in the jointing material and the corresponding skim coat comprises a noncellulosic thickener, it is notoriously well known in the art of jointing material that noncellulosic thickener can be used in combination with the normal cellulosic thickeners. For example, Attard et al. teaches a jointing compound comprising a noncellulosic thickener of acidic acrylate copolymers and a cellulosic thickener of hydroxypropyl methylecellulose (column 3, lines 20-34) in order to improve crack resistance (column 2, lines 54-56) and reduce mixing times (column 2, lines 1-3). It would have been obvious to one ordinary skill in the art to modify Zuber et al. to include a noncellulosic thickener and starch, such as taught by Attard et al., in order to create a stronger and quicker to use jointing compound. Furthermore, because the applicant fails to show critically for the different percentages of each member of the composition claimed, the weight percentages listed are considered a matter of obvious design choice.

f. Regarding claim 63, Zuber et al. discloses a method for the construction of an interior construction system comprising the steps of assembling prefabricated skim coated drywall elements by jointing material (page 1, lines 14-17; page 15, lines 7-10), wherein the skim coat (page 15, lines 10-13) and the jointing material form a substantially planar outer surface and substantially match when dry (page

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15, lines 10-19), and drying the jointing material (page 20, line 4). The skim coat comprises a matching composition to the jointing material except with about 10 to 60% additional water (page 17, line 22). The jointing material comprises water (page 11, line 4), an organic binder (page 9, line 12-14), a mineral filler (page 10, line 15), a silicate-based agent (page 9, lines 1-3; page 10, line 21), a hydrophobic agent which is a silicone derivative (page 9, lines 1-3; page 10, line 18), and polyvinyl alcohol (page 9, lines 12-14) and a thickener (page 9, 18-20), and talc (page 18, lines 18-19). While Zuber et al. does not disclose that the thickener used in the jointing material and the corresponding skim coat comprises a noncellulosic thickener, it is notoriously well known in the art of jointing material that noncellulosic thickener can be used in combination with the normal cellulosic thickeners. For example, Attard et al. teaches a jointing compound comprising a noncellulosic thickener of acidic acrylate copolymers and a cellulosic thickener of hydroxypropyl methylecellulose (column 3, lines 20-34) in order to improve crack resistance (column 2, lines 54-56) and reduce mixing times (column 2, lines 1-3). It would have been obvious to one ordinary skill in the art to modify Zuber et al. to include a noncellulosic thickener and starch, such as taught by Attard et al., in order to create a stronger and quicker to use jointing compound. Furthermore, because the applicant fails to show critically for the different percentages of each member of the composition claimed, the weight percentages listed are considered a matter of obvious design choice.

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g. Regarding claims 2, 11, 20, 29, 38, 48, 57 and 64, the jointing material and the skim coat form a substantially homogeneous outer surface on the substantially planar outer surface (page 20, lines 6-9).

h. Regarding claims 3, 12, 21, and 30, at least one of the parameters in the group consisting of coloration, reflectance factor and surface water absorption is substantially homogeneous over the substantially planar outer surface (page 20, lines 9-13).

i. Regarding claims 4, 13, 22 and 31, the jointing material and the skim coat exhibit substantially the same surface water absorption when dry (page 20, lines 9-13).

j. Regarding claims 5, 14, 23, 32, 39, and 58, the surface water absorption, as measured by the drop test, is at least 45 minutes for both the jointing material and the skim coat (page 13, line 3; page 11, line 21-22; page 12, line 1-3).

k. Regarding claims 6, 15, 24, 33, 40, 49, 59, and 65, Zuber et al. discloses a coating formulation further comprising dispersant (page 10, line 22), anti-cracking agent (page 18, lines 18-20) and workability agent (page 18, line 17).

Because the applicant fails to show critically for the different percentages of each member of the composition claimed, the weight percentages listed are considered a matter of obvious design choice.

l. Regarding claims 7, 16, 25, 34, 41, 50, 60, and 66, the anti-cracking agent is mica (page 18, lines 18-20) workability agent is clay (page 18, line 17; page 9, lines 21-22).

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m. Regarding claims 8, 17, 26, 35, 42, 51, 61, and 67 the mineral filler comprises more than about 60% calcium carbonate (page 10, line 15; page 18, line 12).

n. Regarding claims 9, 18, 27, 36, 46, 55, 62, and 68, the drywall elements are gypsum wallboard (page 1, lines 16-17).

o. Regarding claims 43 and 52, Zuber et al. discloses a thickener (page 9, 18-20), which could be a cellulose derivative of the methylhydroxyethylcellulose type (page 10, line 19). Zuber et al. does not disclose that the thickener and the water retention agent in the jointing material comprises hydroxypropyl methylecellulose. However, it is notoriously well known in the art of jointing compounds that a common cellulose derivative thickener is hydroxypropyl methylecellulose. For example, Attard et al. teaches a jointing compound comprising a noncellulosic thickener of acidic acrylate copolymers and a cellulosic thickener of hydroxypropyl methylecellulose (column 3, lines 20-34) in order to improve crack resistance (column 2, lines 54-56) and reduce mixing times (column 2, lines 1-3). It would have been obvious to one ordinary skill in the art to modify Zuber et al. to include a noncellulosic thickener of acidic acrylate copolymers and a cellulosic thickener of hydroxypropyl methylecellulose, such as taught by Attard et al., in order to create a stronger and quicker to use jointing compound.

p. Regarding claims 44 and 53, the composition of the jointing material and the skim coat are the same, except for that the skim coat will generally comprise

additional water (page 17, lines 18-22). Therefore the binder in the coating formulation of the skim coat and the binder in the jointing material will be the same.

q. Regarding claims 45 and 54, the binder in the jointing material can be an acrylic polymer (page 10, line 16-17).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Plummer whose telephone number is (571) 272-2246. The examiner can normally be reached on Monday through Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on (571) 272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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